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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,565	08/01/2001	Michael Loeb	52846-5002-01	4841
28977	7590	11/10/2003	EXAMINER	
MORGAN, LEWIS & BOCKIUS LLP 1701 MARKET STREET PHILADELPHIA, PA 19103-2921				COSIMANO, EDWARD R
ART UNIT		PAPER NUMBER		
		3629		

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/920,565	LOEB ET AL.	
	Examiner	Art Unit	
	Edward R. Cosimano	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 August 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,23-25,31,33,34 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,23-25,31,33,34 and 37-44 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 August 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 | 6) <input type="checkbox"/> Other: _____ |

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. The disclosure is objected to because of the following informalities:
 - A) applicant must update:
 - (1) the continuing data on page 1,
with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.
Appropriate correction is required.
3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
4. Claims 1, 2, 23-25, 28, 31, 33, 34 & 37-44 are rejected under the judicially created doctrine of double patenting over claims 1-25 of U. S. Patent No. 6,332,124 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.
 - 4.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:
 - A) collection of information/data; and
 - B) sorting/associating the collected information based on some criteria.
 - 4.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent

possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

4.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

4.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

5.1 Claims 1, 2, 23-25, 28, 31, 33, 34 & 37-44 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

5.1.1 Although the instant claims recite:

1) a system, (claims 24, 25, 28 & 40-44), and a method, (claims 1, 2, 23, 31, 33, 34 & 37-39), which has a practical application in the technological arts, and

2) which does not define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon,

the instant claims merely define a series of steps to be performed on a computer.

5.1.2 In regard to claims 1, 2, 23-25, 28, 31, 33, 34 & 37-44, the invention as set forth in these claims merely describes the concept of collecting information and sorting/associating the collected information, however, as recited in these claims neither collected information nor sorted/associated information are tangibly used in a concrete manner so as to produce a concrete and tangible result with in the technological arts.

5.1.3 It is further noted that applicant has not claimed a specific process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which is either altered or changed or modified by the invention recited in claims

5.1.4 It is further noted that applicant has not claimed either:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or changed before it is processed, or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation is either manipulated or used or changed by any device after it has been processed.

5.1.5 In view of the above, the invention of claims 1, 2, 23-25, 28, 31, 33, 34 & 37-44 merely manipulates the abstract idea of:

A) the creation of a data structure by collecting information and then sorting/associating the collected information.

5.1.6 In view of the above, it is further noted that the invention of claims 1, 2, 23-25, 28, 31, 33, 34 & 37-44 lacks a claimed practical application since the claimed invention, either:

A) does not have the functionality required to carry out the recited steps or functions of the claimed invention; or

B) is not used by any system or device or method outside of the claimed invention,

in a concrete and tangible manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578; and State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)).

5.1.7 It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function descriptive material, (note In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

5.1.7 Hence, claims 1, 2, 23-25, 28, 31, 33, 34 & 37-44 are directed to non-statutory subject matter.

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6.1 Claims 1, 2, 23-25, 28, 31, 33, 34 & 37-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over {fill in}.

6.1.1 In regard to:

- A) the source of the data/information, for example, fulfillment houses;
- B) the nature of the data/information, for example, subscriptions; and
- C) the organizing data, for example, consumer household;

Since these features do not affect how the apparatus/method would operate, these features are considered to be nonfunctional descriptive material. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

6.2 Claims 1, 2, 23-25, 28, 31, 33, 34 & 37-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Dworkin (4,992,940) or Sansone et al (5,051,914) or Linge et al or Cox et al (5,907,845) in view of an obvious application of the teachings of either Dworkin (4,992,940) or Sansone et al (5,051,914) or Linge et al or Cox et al (5,907,845).

6.2.1 In regard to claims 1, 2, 23-25, 28, 31, 33, 34 & 37-44, any one of Dworkin ('940) or Sansone et al ('914) or Linge et al or Cox et al ('845) disclose a computerized customer service system in which data from a number of different sources is collected and organized into categories according to the customer's request. For example, note:

A) Dworkin ('940) in which catalog information from a number of vendors is collected and organized by category so that the customer may see similar products from each of the vendors without having to search each of the catalog separately.

B) Sansone et al ('914) in which mailing information from a number of sources is collected, merged and organized by recipient/household so that the mailers may receive a lower overall postage cost per recipient/household and the recipient/household may receive one mailing.

C) Linge et al in which customer service information from a number of sources is collected, merged and organized by recipient/household so that the customer may have one location to obtain the customer service information.

D) Cox et al ('845) in which various types of information from a number of different sources is collected and organized by category so that the customer may review the collected information from a single location.

Further any one of Dworkin ('940) or Sansone et al ('914) or Linge et al or Cox et al ('845) receive shipping and billing information from the customers as matter of common practice

6.2.2 Neither Dworkin ('940) nor Sansone et al ('914) nor Linge et al nor Cox et al ('845) disclose that information that is collected, merged and organized is subscription data. However, since a customer would receive subscriptions from number of different

locations/publishers and hence receive a number of separate bills, see the background of the invention, it would have been obvious to one of ordinary skill at the time the invention was made that from a customer service point of view the customer's subscription information could be collected, merged and organized as taught by either Dworkin ('940) or Sansone et al ('914) or Linge et al or Cox et al ('845).

6.2.3 In regard to claims 37-41, since the systems of either Dworkin ('940) or Sansone et al ('914) or Linge et al or Cox et al ('845) are computerized, these system inherently have the a control program stored in a memory that controls the operation of these systems.

7. The examiner has cited prior art of interest, for example:

A) either Dworkin (4,992,940) or Sansone et al (5,051,914) or Otsuka et al (JP 08-129594) or Linge et al or Cox et al (5,907,845) or the Business Week article, ,or the Business Wire article or Marques (6,182,066 or 2001/0013047) or Frauenhofer et al (6,236,991) or Bahlmann (6,578,074), each disclose a computerized system for centrally collecting information, merging the collected information and organizing the collected and merged data.

8. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

- 9.1 The fax phone number for **UNOFFICIAL/DRAFT FAXES** is (703) 746-7240.
- 9.2 The fax phone number for **OFFICIAL FAXES** is (703) 872-9306.
- 9.3 The fax phone number for **AFTER FINAL FAXES** is (703) 872-9306.

10/31/03

Edward Cosimano
Edward R. Cosimano
Primary Examiner A.U. 3629